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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,867	10/22/2001	Csaba Truckai	SRX-011	7410

7590
Csaba Truckai
19566 Arden Court
Saratoga, CA 95070

11/06/2003

EXAMINER

ROANE, AARON F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,867

Applicant(s)

TRUCKAI ET AL.

Examiner

Aaron Roane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 6-10, 15-17, 24, 25, 31-34, 36-38 and 40-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11-14, 18, 20, 23, 26-30, 35, 39, 47 and 48 is/are rejected.
- 7) ☒ Claim(s) 19, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: Species #1 characterized by figure 1; Species #2 characterized by figures 5-7B; Species #3 characterized by figures 8 and 9; Species #4 characterized by figures 10-12; Species #5 characterized by figures 13 and 14; Species #6 characterized by figure 16; Species #7 characterized by figure 17.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1, 18, 27, 40 and 47 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant's election without traverse of Species #2 in Paper No. 4 is acknowledged.

Applicant states that claims 1-7, 11-16, 18-33, 35, 39-43, 47 and 48 are directed to species #2. However, claims 6, 7, 15, 16, 24, 25, 31, 32, 33 and 40-43 are directed to a non-elected species. Species #2 is characterized by the Type "B" embodiment detailed in the specification, claims 6, 7, 15, 16, 24, 25, 31, 32, 33 and 40-43 are directed to and detailed in the sections regarding Types C-F. Therefore, claims 6, 7, 15, 16, 24, 25, 31, 32, 33 and 40-43 will also be withdrawn from further consideration and only claims 1-5, 11-14, 18-23, 26-30, 35, 39, 47 and 48 will be examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 35 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 35 is directed to the use of zirconium oxide within the variable resistive material. However zirconium oxide is not disclosed in the background of invention, summary of invention or detailed description of invention sections of the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 11, 12, 18, 23, 26-30, 39, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yates et al. (USPN 5,403,312) in view of Yates (USPN 5,716,366).

Regarding claims 1-4, 11, 13, 18, 23, 26-30 and 39, Yates et al. disclose an electrosurgical hemostatic device comprising a jaw structure having first (32) and second

(34) jaw members moveable between an opened and closed position, first (+ electrode of figures 11-14) and second (- electrode of figures 11-14) polarity conductive electrodes or conductive body portions coupled to a voltage source, a surface engagement plane of jaw members having an exposed portion of both the first and second body portions or polarity conductive electrodes, see col. 2, 3, col. 5, line 33 through col. 6, line 23, col.8, line 59 through col. 9, line 38 and figures 1-6 and 11-14. Yates et al. also disclose that RF is used in order to energize the electrodes or body portion in order to cauterize the tissue, see col. 4, lines 15-40. Yates et al. fails to disclose one polarity conductive electrode or body portion constructed of a variable resistance material. Yates discloses a device very similar to the one disclosed by Yates et al. in design and intent and teaches that a body portion (39) maybe constructed from a positive temperature coefficient (PTC) material as an alternative hemostatic means, see col. 1, line 47 through col. 2, line 34, col. 3, lines 44-59 and figures 1-4 and 14-16. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Yates et al., as taught by Yates, to provide an alternate hemostatic means by constructing a body portion from a positive temperature coefficient (PTC) material.

Regarding claim 12, Yates et al. in view of Yates disclose the claimed invention of an NTC material, see Yates col. 7, lines 7-23.

Regarding claims 47 and 48, Yates et al. disclose an electrosurgical hemostatic device comprising a jaw structure having first (32) and second (34) jaw members moveable

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between an opened and closed position, first (+ electrode of figures 18 or 19), second (one - electrode of figures 18 or 19) and a third (the other - electrode of figures 18 or 19) polarity conductive electrodes or conductive body portions coupled to a voltage source, a surface engagement plane of jaw members having an exposed portion of both the first and second body portions or polarity conductive electrodes, see col. 2, 3, col. 5, line 33 through col. 6, line 23, col. 8, line 59 through col. 9, line 38 and figures 1-6 and 11-14. Yates et al. also disclose that RF is used in order to energize the electrodes or body portion in order to cauterize the tissue, see col. 4, lines 15-40. Yates et al. fails to disclose one polarity conductive electrode or body portion constructed of a variable resistance material. Yates discloses a device very similar to the one disclosed by Yates et al. in design and intent and teaches that a body portion (39) maybe constructed from a positive temperature coefficient (PTC) material as an alternative hemostatic means, see col. 1, line 47 through col. 2, line 34, col. 3, lines 44-59 and figures 1-4 and 14-16. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Yates et al., as taught by Yates, to provide an alternate hemostatic means by constructing a body portion from a positive temperature coefficient (PTC) material.

Claims 5, 13, 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yates et al. (USPN 5,403,312) in view of Yates (USPN 5,716,366) as applied to claim 18 above, and further in view of Wallstén (USPN 5,571,153).

Regarding claim 5, Yates et al. in view of Yates disclose the claimed invention except for disclosing that the PTC is made of ceramic. It is well known in the art that PTC may be made of a ceramic as is shown by Wallstén. Wallstén discloses a hyperthermia treatment device with a PTC-type heat self-regulating element having a Curie point and teach that it is known to provide a PTC material in the form of ceramic, see col. 7, lines 4-13.

Regarding claims 13, 14 and 20, Yates et al. in view of Yates disclose the claimed invention except for disclosing that the PTC material has a switching range (or Curie point) between 40° C to 200° C, and that the resistance varies by greater than 5% when the temperature changes by 5%. Wallstén discloses a hyperthermia treatment device with a PTC-type heat self-regulating element having a Curie point and teach that a suitable PTC-type material has a 70° C Curie point, see col. 8, lines 28-33. Furthermore, Wallstén also disclose that PTC-type material exhibit 20%-30% increase in resistance per degree (increase) in temperature is known in the art, see col. 3, lines 17-27 and figure 6.

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Yates et al. in view of Yates, as taught by Wallstén, to use a PTC-type material that has a 70° C Curie point and exhibits 20%-30% increase in resistance per degree (increase) in temperature in order to self regulate or self control heating.

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Allowable Subject Matter

Claims 19, 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

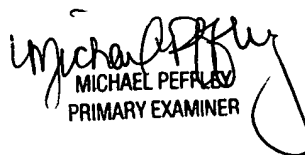
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (703) 305-7377. The examiner can normally be reached on 9am - 5pm, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

A.R. A. R.
October 28, 2003


MICHAEL PEFFLEY
PRIMARY EXAMINER